

REMARKS

Claims 1-11 are pending in this application, with Claims 1, 6 and 11 being the independent claims. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Westling (US 2006/0041474). Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. The Examiner asserts that the claims contain subject matter not supported by the Specification, specifically the recitation "a method for reducing a call fee." Claim 6 is rejected under 35 U.S.C. 112, second as being indefinite, because the claim does not describe in what memory the scheduled data is stored. The Examiner then interprets the limitation as storing schedule data in the memory of the mobile terminal.

Reconsideration of this application is respectfully requested.

Westling discloses a system for promoting computer network pages. The system includes a mobile station that allows a user to conduct a telephone call and connect to a computer network. A call management server selects and transmits an audible advertisement for a network page to a user, based on profile information of the user. A gateway then causes a menu including a selection choice for connecting to the advertised computer network page to appear on the mobile station when the user connects to the computer network.

Regarding the enablement rejection, the Examiner specifically points to the recitation "a method for reducing a call fee" as not supported by the Specification; the Examiner further stated the Specification is not enabling in describing how a mobile subscriber would receive a "reduce call fee"; and further states the Specification only mentions displaying advertisements in a mobile terminal without describing how said

displaying would cause a “reduce of call fee” to said mobile terminal users. Applicants respectfully disagree.

When basing a rejection on the failure of the applicant’s disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. 112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973). MPEP 2162.01(III). The linchpin of 112 first paragraph is “undue experimentation.” (emphasis added). The Examiner failed to articulate a reasonable basis, because no experimentation is required in order to make and use the present invention. The disclosure makes it clear that it is an object of the invention to provide a method for receiving a desired advertisement together with its associated advertisement schedule using the SMS service and displaying the received advertisement according to the advertisement schedule in a portable mobile terminal. This process inherently reduces a call fee since a call is not placed to gain access to the SMS. The message is local to the portable terminal. There is no experimentation required by the average individual to access an SMS message on a portable terminal.

Accessing the Internet through a portable terminal is inconvenient and would incur a fee. Consequently, a better method is needed to remedy this situation. The invention provides a method of utilizing short message service (SMS) to receive desired advertisements. There is no fee involved in accessing SMS. The user would access a web site server of an SMS-based advertisement service provider to select a desired advertisement and a desired advertisement time and to input a phone number of the portable mobile terminal; and receives advertisement data of the selected advertisement

and associated advertisement schedule from the web site server, through an SMS message. (See page 3). There is no experimentation required by the average individual to perform the above steps. The “reduce call fee” is inherent in that the user accesses the Internet using a regular PC rather than the portable terminal. Subsequently, the advertisement is sent to the phone number provided using SMS. The user would access the message on the portable terminal without incurring a fee since a call is not involved.

Regarding the rejection of Claim 6 as being indefinite, applicants have no objection regarding the Examiner’s interpretation.

For Claim 1, the Examiner alleges that Westling anticipates the present invention. As an initial matter, Westling was filed on July 27, 2005 as a continuation of an application filed on May 19, 2000. That application is abandoned as of November 10, 2005 and was never published. MPEP §901.02 provides: “Where an >unpublished< abandoned application is identified or whose benefit is claimed in a US patent...the file contents of the unpublished abandoned application may be made available to the public. Subject matter from abandoned applications which is available to the public under CFR 1.14(a) may be used as prior art against a pending U.S. application under 35 U.S.C. 102 (a) or 102(b) as of the date the subject matter became publicly available. (emphasis added)

CFR 1.14(a)(iv) provides: “The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, ... a U.S. patent application publication.” The earliest the abandoned application was made available to the public is February 23, 2006, the date of the Westling’s

application publication. The present application was filed on December 12, 2001; therefore Westling cannot be used as prior against the present application.

Assuming arguendo that Westling is a valid reference, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." See MPEP 706.02(IV). At the very least, Westling does not teach receiving and storing advertisement data and advertisement schedule data from an SMS based advertisement service provider. Accordingly, Westling fails to anticipate the present invention.

The operation of the Westling computer network pages promotion is very different from the method recited in Claim 1. Claim 1 recites a method for reducing a call fee by improving the efficiency of mobile communication by utilizing a short message service (SMS) in a portable mobile terminal to display an advertisement. Westling does not utilize a short message service (SMS) to display an advertisement. Westling discloses a short message service (SMS) to advertise a Wireless Application Protocol (WAP) page (See para. 0044), contray to the present invention which utilizes a short message service (SMS) to display the advertisement at a time chosen by the user. With Westling, the user still has to access the Internet to view the page whereas in the present invention the user need not access the Internet because the advertisement is stored locally on the portable terminal. Claim 1 is patentably distinct from the cited reference.

Claim 6 recites a method for accessing a server of an SMS-based advertisement service provider to select at least one desired advertisement and at least one desired advertisement time and to input a phone number of the portable mobile terminal for receiving data related to a selected advertisement. Westling only teaches that the user may originally receive a SMS message advertising a WAP page and then an audible

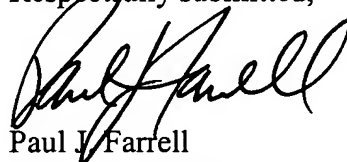
advertisement at a later time. (para. 0045). Westling does not recite storing the received advertisement data in memory of the portable terminal in a predetermined advertisement format. Consequently, Claim 6 is patentably distinct from the cited reference.

Claim 11 recites a method for checking an advertisement identifier (Ad ID) of a received message to determine whether the received message is an advertisement message. Westling only teaches that when a user desires to connect to the Internet, the user causes a signal identifying the user to be sent from mobile station to the WAP gateway through a base transceiver station. The identifying information may include the mobile station's electronic serial number (ESN). (See para. 0039). Westling does not recite an advertisement identifier (Ad ID) of a received message to determine whether the received message is an advertisement message. Consequently, Claim 11 is patentably distinct from the cited reference.

Independent Claims 1, 6 and 11 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-5, and 7-10, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-5, and 7-10 are respectfully requested.

Accordingly, all of the claims pending in the Application namely, Claims 1-11, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul J. Farrell", written over the printed name.

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